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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/296,264	04/22/1999	JIM A. WRIGHT	032396-043	8152

7590 06/05/2002

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EXAMINER	
SCHMIDT, MARY M	
ART UNIT	PAPER NUMBER
1635	

DATE MAILED: 06/05/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/296,264	WRIGHT ET AL.	
	Examiner	Art Unit	
	Mary Schmidt	1635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 April 2002* .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-30* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. The Amendment filed 4/29/02 has been entered. Claims 1 and 3-25 reiterated in the Amendment were not entered since they did not further amend the claims. The claims as amended to claim specific nucleic acid sequences, are subject to the following restriction:

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-30, drawn to antisense to human neuropilin gene, including SEQ ID NO:33, and compositions comprising said antisense and methods of using said antisense, classified in class 536, subclass 23.1 and 24.5.

II. Claims 1-23 and 25-30, drawn to antisense to rat neuropilin gene, including SEQ ID NO:34, and compositions comprising said antisense and methods of using said antisense, classified in class 536, subclass 23.1 and 24.5.

III. Claims 1-23 and 25-30, drawn to antisense to mouse neuropilin gene, including SEQ ID NO:35, and compositions comprising said antisense and methods of using said antisense, classified in class 536, subclass 23.1 and 24.5.

3. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different

inventions have different modes of operation. Groups I-III are drawn to antisense to target neuropilin genes from different species. The sequence structure of the rat, human and mouse genes are known to be structurally different in the art and are patentably different gene sequences. It follows that the design of antisense to the different target genes are patentably distinct as well as the compositions comprising said antisense, and methods of using said antisense to the different genes since the design of antisense is dependent on the sequence structure of the target gene and the antisense instantly claims would have patentably distinct sequence structures since they target different gene sequences. As such, the antisense to human, rat or mouse neuropilin genes have different modes of operation since they have different sequence structures and would bind distinctly to the target sequence having the complementary sequence.

4. Furthermore, should the invention of Group I be elected, the following restriction is required of claim 24 drawn to specific antisense oligonucleotides to human neuropilin gene.

5. Pursuant to 35 U.S.C. 121 and 37 C.F.R. 1.141, the antisense sequences listed in claim 24 is subject to restriction. As per M.P.E.P. 2434, "the Commissioner has partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of such nucleotide sequences to be claimed in a single application. Under this policy, in most cases, up to 10 independent and distinct nucleotide sequences will be examined in a single application without

restriction. Those sequences which are patentably indistinct from the sequences selected by the applicant will also be examined."

Claim 24 specifically claims SEQ ID NOS: 1-30. Each of these antisense sequences is considered to be structurally independent and distinct even though they each target the same human neuropilin gene, because each of these antisense has a unique nucleotide sequence and each targets a different and specific region of the gene. Furthermore, a search of all the antisense sequences claimed in claim 24 presents an undue burden on the Patent and Trademark Office to search and examine all of the recited sequences. In view of the foregoing, applicants are required to elect up to 10 claimed antisense sequences from claim 24.

Therefore, since claims 1-23 and 25-30 are generic for antisense to human, rat or mouse, the claims, in view of the above restriction requirement, Applicant is advised that upon election of Group I, II or III, the generic claims 1-23 and 25-30 will only be examined to the extent that they read on the elected species: human, rat or mouse.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Mary M. Schmidt*, whose telephone number is (703) 308-4471.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *John LeGuyader*, may be reached at (703) 308-0447.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Analyst, *Kay Pinkney*, whose telephone number is (703) 305-3553.

JOHN L. LeGUYADER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

M. M. Schmidt
June 3, 2002